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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,254	02/01/2002	Yoshiki Nakagawa	011300	7001

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ARMSTRONG, WESTERMAN & HATTORI, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

10

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,254

Applicant(s)

NAKAGAWA ET AL.

Examiner

Donald R Wilson

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION**Response to Election/Restrictions**

1. Applicant's election of the inventions of Group I, Claims 1-23, and the species of (a) a butyl/acrylate/ethyl acrylate/methoxyethyl acrylate as the vinyl polymer, (b) an alkenyl group as an initial terminal group, and (c) potassium acetate as the oxy anion compound, in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Further Restriction/Election Requirement

2. On a closer reading of the claims the Examiner revises the restriction requirement to include a fourth group directed to a method of treating a halogen group-containing vinyl polymer with an oxy anion, further comprising the step of adding a hydrogen silane compound to the terminal alkenyl group, which was formerly included in the Group I claims. This further group is also not so linked as to form a single general inventive concept under PCT Rule 13.1 for the same reasons previously presented, i.e.,

“--- under PCT Rule 13.2, they lack the same or corresponding special technical feature(s), or the special technical feature(s) does not define a contribution over the prior art for the following reasons: Claim 1 is either obvious or anticipated over Nakagawa. Nakagawa discloses vinyl polymers with alkenyl-carboxylate end-groups (Claim 1, formula(6)), which are prepared by polymerization of a vinyl monomer using atom transfer radical polymerization, and converting a terminal halogen group to the alkenyl-containing substituent (e.g., see Example 15, Claims 7-8, and col. 15, lines 47-64). The process clearly falls within the limits of instant Claim 1. Accordingly, the special technical feature linking the inventions, does not provide a contribution over the prior art.”

3. The groups are now as follows

- a. Group I, claim(s) 1-5 and 23, drawn to a method of treating a halogen group-containing vinyl polymer with an oxy anion.
- b. Group II, claim(s) 24-25, drawn to vinyl polymers having ether- or ester-containing end group.
- c. Group III, claim(s) 26, drawn to curable compositions having a vinyl polymer with alkenyl-containing end groups.
- d. Group IV, claim(s) 6, drawn to a method of treating a halogen group-containing vinyl polymer with an oxy anion further comprising the step of adding a hydrogen silane compound.

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4. The election of species requirement remains the same as previously stated except that the selection of Group IV inventions would require an election of species of (a) (b), (c) and (d), i.e., the species are as follows:

- a. vinyl polymers (Groups I-IV),
- b. initial terminal groups on the vinyl polymer (Groups I-IV), and
- c. oxy anion compounds (Groups I-IV).
- d. hydrosilyl group containing compounds (Groups IV).

Conclusion to Restriction Election Requirement

5. A telephone call was made to Mr. Stephen G. Adrian on 7/29/03 to request an oral election to the above further restriction requirement, but did not result in an election being made.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

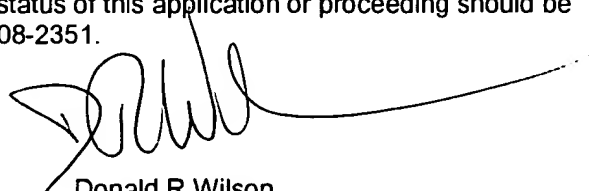
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



Donald R Wilson
Primary Examiner
Art Unit 1713